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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,289	11/28/2000	David M. Bankers	L294.12-0010	7557
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KINNEY & LANGE, P.A. THE KINNEY & LANGE BUILDING 312 SOUTH THIRD STREET MINNEAPOLIS, MN 55415-1002			VU, NGOC K	
			ART UNIT	PAPER NUMBER
			2611	

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/724,289

Applicant(s)

BANKERS ET AL.

Examiner

Ngoc K. Vu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/6/05</u> . | 6) <input type="checkbox"/> Other: _____  |

***Response to Arguments***

1. Applicant's arguments with respect to claims 1-29 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (US 20030149988 A1) in view of Ohno et al. (US 5,781,734 A).

Regarding claim 1, Ellis discloses a method of guest-selected recording of television programs in an entertainment system (see figures 2a-d) having a head end (16) and a plurality of terminals (22) connected by a distribution system (via 20), the method comprising:

creating, at the headend, a schedule (program guide as shown in figures 11a-11c, 14d-14e and 18b-18d) containing both television programs available for viewing and recording and previously recorded television programs available for time-shifted viewing (the program guide comprises program listings available for viewing and recording and viewing the recorded programs - see 0064, 0125, 0126, 0145, 0146);

transmitting, from the headend to a terminal, the schedule (program guide) created (see 0064; 0125-0126 and 0156);

transmitting, from the terminal to the head end, program recording selection data representing a program selected by a viewer for recording (see 0076 and 0084);

creating, at the headend (via processing circuitry 11), a digital file representing the program selected (encoding program as digital file - see 0089 and figures 2a-5);

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storing, at the headend, the digital file (in storage 15 – see 0079; 0089);

updating, at the headend, the schedule of television programs to include the program corresponding to the digital file (it must be understood that the program guide is updated in order to schedule appropriately the programs including the program corresponding to the digital file; see 0089 and 0120);

transmitting the schedule as updated from the headend to the terminal (see 0097 and 0121);

transmitting, from the terminal to the head end, data requesting playback of the program selected for recording based upon a selection of that program from the schedule as updated (viewer transmits a request for playback a selected program for recording – 0151, 0156);

playing back, at the headend, the program selected based upon the digital file representing the program selected (the remote server 24 may playback the selected program in response to playback requested from user – see 0156); and

transmitting the program being played back to the terminal (see 0156 and 0157).

Ellis's system allows viewers in a plurality of locations to direct the headend, i.e., server, to record certain programs that later may be play back to the viewer on demand. Ellis does not explicitly teach that the entertainment system at a lodging facility and the plurality of terminals in a plurality of guest rooms. However, Ohno teaches an audio/video services system of a hotel for providing audio/video services on demand. Particularly, the system comprises a system management room 10 included a plurality of recorders VTRs for providing video such as movies, a plurality of terminal sections in a plurality of guest rooms R1- Rk, and a coaxial cable 20 (see col. 2-3, lines 66-3 and figure 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Ellis by including a system management room, a plurality of terminal sections in a plurality of guest

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rooms, and a coaxial cable for distributing audio and video services to guest rooms in a hotel as taught by Ohno in order to provide audio and video services on demand to many locations such as guest rooms in the hotel with a simple and low-cost structure.

Regarding claim 8, Ellis discloses a method of guest-selected recording of television programs in an entertainment system (see figures 2a-d) having a head end (16) and a plurality of terminals (22) connected by a distribution system (via 20), the method comprising:

transmitting, from a headend (16) to a terminal, a schedule (program guide) containing both scheduled programs available for viewing and recording and previously recorded television programs available for time-shifted viewing (program guide contains programs scheduled for recording and viewing and previously recorded programs stored in remote server 24 for playback on-demand – see 0064; 0125-0126 and 0156);

receiving, from the terminal, program selection data representing in a scheduled program selected for recording (see 0076 and 0084);

digitally storing the program selected, at the headend, when it is broadcast (in storage 15 of remote server 24 – see 0079; 0089);

updating the schedule, at the headend, to include the program selected as one of the previously recorded programs (it must be understood that the program guide is updated in order to schedule appropriately the programs including the previously recorded program - see 0089; 0120; 0156 and figures 11b-11c);

receiving at the headend, from the terminal request data based on the previously recorded programs contained in the program schedule (receiving request from user for playback a previously recorded program contained in the program guide – see 0156);

converting at the headend, in response to the playback request data, the digitally stored program to television signals (converting program to suitable video signal for distribution - see 0077); and

transmitting the television signals from the headend to the terminal (see 0157).

Ellis's system allows viewers in a plurality of locations to direct the headend, i.e., server, to record certain programs that later may be play back to the viewer on demand. Ellis does not explicitly teach that the system comprises a guest terminal in a guest room in a lodging facility. However, Ohno teaches an audio/video services system of a hotel for providing audio/video services on demand. Particularly, the system comprises a system management room 10 included a plurality of recorders VTRs for providing video such as movies, a plurality of terminal sections in a plurality of guest rooms R1- Rk, and a coaxial cable 20 (see col. 2-3, lines 66-3 and figure 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Ellis by including a system management room, a plurality of terminal sections in a plurality of guest rooms, and a coaxial cable for distributing audio and video services to guest rooms in a hotel as taught by Ohno in order to provide audio and video services on demand to many locations such as guest rooms in the hotel with a simple and low-cost structure.

Regarding claims **15, 24 and 29**, Ellis discloses an entertainment system comprising:

a plurality of terminals (22);

a distribution system (20) connected to the terminals; and

a headend (16) comprising:

a digital a content server (24) for storing entertainment content in digital files and supplying to the distribution system television signals based upon the digital files (see 0077 and 0089);

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a receiver (within 21) for receiving television programs on a plurality of channels and supplying the programs to the distribution system (see 0064-0065);

an encoder (within 11) for converting (encoding) a selected television program on one of the channels to digital file representing the selected program and transferring the digital file to the digital content server (storage 15 in server 24) for storage (see 0088; 0089); and

a computer (11) which communicates with the terminals (22) over the distribution system (20), the computer providing the terminals with a schedule (program guide) listing both the television programs available for viewing and recording and previously recorded programs available for time-shifted viewing (program guide contains programs scheduled for recording and viewing and recorded programs stored in remote server 24 – see 0064 and 0125-0126), controlling operation of the encoder based upon a selection by a viewer of a program to be recorded (in response to request for recording a selected program) and controlling operation of the digital content server based upon a selection by a viewer of a previously recorded program for time-shifted viewing (in response to request for playback a previously recorded program) (see 0077, 0088, 0089 and 0156-0157).

Ellis's system allows viewers in a plurality of locations to direct the headend, i.e., server, to record certain programs that later may be play back to the viewer on demand. Ellis does not explicitly teach that the system comprises a guest terminal in a guest room in a lodging facility. However, Ohno teaches an audio/video services system of a hotel for providing audio/video services on demand. Particularly, the system comprises a system management room 10 included a plurality of recorders VTRs for providing video such as movies, a plurality of terminal sections in a plurality of guest rooms R1- Rk, and a coaxial cable 20 (see col. 2-3, lines 66-3 and figure 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Ellis by including a system management room,

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a plurality of terminal sections in a plurality of guest rooms, and a coaxial cable for distributing audio and video services to guest rooms in a hotel as taught by Ohno in order to provide audio and video services on demand to many locations such as guest rooms in the hotel with a simple and low-cost structure.

Regarding claim 21, Ellis discloses a method of providing viewer-selected viewing of time-shifted television programs in an entertainment system (see figures 2a-d) having a head end (16) and a plurality of terminals (22) connected by a distribution system (via 20), the method comprising:

tuning to channels on which scheduled television programs selected for time-shifting are carried (see 0088);

encoding the program into a digital format to create a digital file (see 0088 and 0089);

storing the digital files at the headend (in storage 15 of remote server 24 in facility 16 – see 0079; 0089);

transmitting, from the headend to a terminal, an interactive schedule (program guide) listing both scheduled programs available for viewing and previously recorded television programs available for time-shifted viewing based upon the digital files stored (program guide contains programs scheduled for viewing and previously recorded programs stored in remote server 24 for playback on-demand – see 0064 and 0125-0126);

transmitting, from the terminal to the headend, data requesting playback of one of the time-shifted television programs displayed (receiving request transmitted from user for playback a selected program stored in the remote server 24 – see 0156);

playing back the time-shifted program requested based upon the stored digital file representing that program (the remote server 24 may playback the requested recorded program in response to playback requested from user – see 0156); and



transmitting the time-shifted program being played back to the terminal (see 0156 and 0157).

Ellis's system allows viewers in a plurality of locations to direct the headend, i.e., server, to record certain programs that later may be play back to the viewer on demand. Ellis does not explicitly teach that the system comprises a guest terminal in a guest room in a lodging facility. However, Ohno teaches an audio/video services system of a hotel for providing audio/video services on demand. Particularly, the system comprises a system management room 10 included a plurality of recorders VTRs for providing video such as movies, a plurality of terminal sections in a plurality of guest rooms R1- Rk, and a coaxial cable 20 (see col. 2-3, lines 66-3 and figure 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Ellis by including a system management room, a plurality of terminal sections in a plurality of guest rooms, and a coaxial cable for distributing audio and video services to guest rooms in a hotel as taught by Ohno in order to provide audio and video services on demand to many locations such as guest rooms in the hotel with a simple and low-cost structure.

Regarding claim **22**, Ellis discloses a method of providing time-shifted television programs in an entertainment system (see figures 2a-d) having a head end (16) and a plurality of terminals (22) connected by a distribution system (via 20), the method comprising:

digitally storing, at the headend, television programs (in storage 15 of remote server 24) for time-shifted viewing (i.e., playback on-demand), when they are broadcast (see 0079, 0089 and 0157);

transmitting, from the headend to a terminal, a schedule (program guide) containing both scheduled programs available for viewing and recording, and time-shifted television programming based upon television programs digitally stored (program guide contains

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programs scheduled for recording and viewing and recorded programs stored in remote server 24 – see 0064 and 0125-0126);

receiving at the headend, from the terminal, playback request data selecting one of the digitally stored time-shifted television programs (receiving request from user for playback a selected program stored in the remote server 24 – see 0156);

converting at the headend, in response to the playback request data, the selected digitally stored time-shifted television program to television signals (converting program to suitable video signal for distribution - see 0077); and

transmitting the television signals from the headend to the terminal (see 0157).

Ellis's system allows viewers in a plurality of locations to direct the headend, i.e., server, to record certain programs that later may be play back to the viewer on demand. Ellis does not explicitly teach that the entertainment system at a lodging facility and the plurality of terminals in a plurality of guest rooms. However, Ohno teaches an audio/video services system of a hotel for providing audio/video services on demand. Particularly, the system comprises a system management room 10 included a plurality of recorders VTRs for providing video such as movies, a plurality of terminal sections in a plurality of guest rooms R1- Rk, and a coaxial cable 20 (see col. 2-3, lines 66-3 and figure 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Ellis by including a system management room, a plurality of terminal sections in a plurality of guest rooms, and a coaxial cable for distributing audio and video services to guest rooms in a hotel as taught by Ohno in order to provide audio and video services on demand to many locations such as guest rooms in the hotel with a simple and low-cost structure.

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Regarding claims **2, 9 and 23**, Ellis discloses tuning to a channel on which a television program is carried; and encoding the program into a digital format to create a digital file (see 0075, 0088 and 0089).

Regarding claims **3 and 11**, Ellis shows creating a recording schedule based upon program recording selection data received (see 0125-0126).

Regarding claim **4**, Ellis discloses creating a digital file (directory) is based upon the recording schedule (see 0145).

Regarding claims **5 and 10**, Ellis discloses associating with the digital file an identification of the terminal (user1, user 2...etc) that provided the program recording selection data (see figure 4 and 0082; 0091).

Regarding claims **6 and 13**, Ellis shows that the schedule of television programs is an interactive program guide (see figures 14b, 14d, 14e and 15a-18c).

Regarding claims **7, 14 and 17**, Ellis discloses that the program recording selection data is produced based upon a selection (i.e., recording a program) made on the interactive program guide (see 0134).

Regarding claim **12**, Ellis discloses digitally storing the program is based upon the recording schedule (see 0079 and 0089).

Regarding claims **16 and 25**, Ellis discloses that the system includes a plurality of tuners for tuning to the channels and an encoding device connected to each tuner (see 0088-0089).

Regarding claim **18**, Ellis shows that the interactive program guide includes information about previously recorded television programs (see 0145, 0156).

Regarding claims **19 and 26**, Ellis discloses that in response to a request from a terminal, the computer causes the digital content server (24) to supply television signals based upon the digital file representing the selected program (see 0089; 0091).

Regarding claims **20 and 27**, Ellis discloses that the computer creates a recording schedule for the encoder based upon data from the terminals representing selections by viewers of programs to be recorded (see 0088; 0125-0126).

Regarding claim **28**, Ellis discloses a method of providing viewer-selected viewing of time-shifted television programs in an entertainment system (see figures 2a-d) having a head end (16) and a plurality of terminals (22) connected by a distribution system (via 20), the method comprising:

creating, at the headend, a recording schedule of a television programs to be recorded for time-shifted viewing (see 0125-0126);

encoding, at the headend, television programs based upon the recording schedule to create a digital files representing time-shifted television programs (see 0088 and 0089);

storing the digital files at a headend (in storage 15 of remote server 24 in facility 16 – see 0079; 0089);

transmitting, from the headend to a terminal, an interactive schedule (program guide) listing both scheduled programs available for viewing and recording and time-shifted television programs available for viewing based upon the digital files stored (program guide contains programs scheduled for viewing and previously recorded programs stored in remote server 24 for playback on-demand – see 0064 and 0125-0126);

transmitting, from the terminal to the headend, a request to view one of the time-shifted television programs (receiving request transmitted from user for playback a selected program stored in the remote server 24 – see 0156); and

transmitting, from the head end to the terminal, the time-shifted television program requested based upon the digital file representing that time-shifted television program (the

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selected program is transmitted to the user from the remote server 24 in facility 16 - see 0156 and 0157).

Ellis's system allows viewers in a plurality of locations to direct the headend, i.e., server, to record certain programs that later may be play back to the viewer on demand. Ellis does not explicitly teach that the entertainment system at a lodging facility and the plurality of terminals in a plurality of guest rooms. However, Ohno teaches an audio/video services system of a hotel for providing audio/video services on demand. Particularly, the system comprises a system management room 10 included a plurality of recorders VTRs for providing video such as movies, a plurality of terminal sections in a plurality of guest rooms R1- Rk, and a coaxial cable 20 (see col. 2-3, lines 66-3 and figure 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Ellis by including a system management room, a plurality of terminal sections in a plurality of guest rooms, and a coaxial cable for distributing audio and video services to guest rooms in a hotel as taught by Ohno in order to provide audio and video services on demand to many locations such as guest rooms in the hotel with a simple and low-cost structure.

### ***Conclusion***

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoc K. Vu whose telephone number is 571-272-7306. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on 571-272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ngoc K. Vu  
Primary Examiner  
Art Unit 2611

November 28, 2005